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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|---|---|---|---|
| 09/832,770 | 04/11/2001 | Carlos De La Huerga | 250591.90279 | 2242 |

7590 04/30/2008

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| EXAMINER | |
|---|---|
| MISKA, VIT W | |

| ART UNIT | PAPER NUMBER |
|---|---|
| 2833 | |

| MAIL DATE | DELIVERY MODE |
|---|---|
| 04/30/2008 | PAPER |

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

| Office Action Summary | Application No. | Applicant(s) | |
|---|---|---|---|
| | 09/832,770 | DE LA HUERGA, CARLOS | |
| | Examiner | Art Unit | |
| | Vit W. Miska | 2833 | |

*-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --*

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

1)☐ Responsive to communication(s) filed on _____.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

4)☒ Claim(s) *1,4,5,7-10 and 12-153* is/are pending in the application.

4a) Of the above claim(s) *12-14,16,18-21,30-32,34,35,37-106 and 109-153* is/are withdrawn from consideration.

5)☒ Claim(s) *1,7,8,15,17,22-27 and 36* is/are allowed.

6)☒ Claim(s) *4,5,9-10,28-29,33,107-108* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

**Application Papers**

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

## DETAILED ACTION

### *Claim Rejections - 35 USC § 103*

Claims 4, 5, 9-10, 28-29 and 33 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yarin (6294999) in view of Mucciacciaro (5239491).

1. Yarin discloses a medication system for performing health safety functions including containers 34 for holding doses of medication, the containers having RF memory device 50 containing specifying information useable to determine a prescribed dosing regimen for the medication (see col. 7, lines 39ff and col. 9, lines 7ff), communication device 36 or 36' (Fig. 13), RF sensors 41 (antennae) defining sensing areas associated with each receptacle 32 for receiving the specifying information, processor 40 receiving the specifying information to identify a prescribed dosing regimen (col. 7, lines 8-9, col. 9, lines 7-20), timing device inherently associated with processor 40 (col. 6, lines 33-34, col. 10, line 60) and necessary to produce the time alerts for the medication, the processor causing the communication means 36 to indicate predetermined times for taking medication, thus performing a health safety function, col. 10, line 66, the processor using the specifying information to determine a predetermined time for taking medications (col. 5, line 31), horizontal senor surface 30

associated with the processor, container 34 with downward surface 34a and RF tag 50 attached thereto, aligners 32 for distinguishing sensing and non-sensing sections.

2. With respect to claim 4, the aligner "indicia" correspond to the circular outlines of the aligners (receptacles) 32 or the green LED's 36 (col. 8, line 37) indicating presence of a container. With respect to claims 9 and 10, the indicia correspond to the outlines of aligners (receptacles) 32 having the shape of the downward facing surface 34a.

3. With respect to claim 28, the sensing sections correspond to the positions of sensors 41 adjacent receptacles 32, and the non-sensing sections correspond to the areas of surface30 with no receptacles and sensors.

4. Regarding claim 33, processor 40 causes the sensor to scan the sensing area to identify specifying devices therein (col. 6, lines 51-52).

5. Yarin does not specifically disclose "visual indicia" as the aligners for the containers. However, the provision of such indicia would be obvious to one of ordinary skill in the art. Mucciacciaro teaches the placement of visual indicia 24 or 12 for identifying medication containers 4 placed on a sensor surface 1. It would therefore be obvious for one of ordinary skill in the art to place such visual indicia on the tray 30 of Yarin to assist in aligning the proper container on sensing surfaces 32 of tray 30, as taught by Mucciacciaro.

6. Claim 107 is rejected under 35 U.S.C. 103(a) as being unpatentable over Glynn (5774865).

The reference discloses an apparatus and method for performing health safety functions including containers 1,2,4 for holding doses of medication, machine readable and writable memory strips 3,5,7, respectively, containing specifying information ( medicine identity, col. 4, line 38) usable to determine a prescribed dosing regimen (col.4, line 57-58), sensor 13 with sensor area 9 for receiving several specifying devices 3,5,7 receiving the specifying information, sensor 13 linked to processor 21 (Fig. 4B), using the information to identify a prescribed dosing regimen (col. 5, line 18), and performing a health safety function (alarm reminders, col. 5, line 29).

The specifying information is disclosed as being at least the identity of the medication (col. 4, line 38). Processor 21 stores dosage regimens for each of the medications (col. 4, line 58, col. 5, line 18.

Glynn suggests the specifying information or medicine identity information of the medication containers o the tray is first input into the RAM of the microprocessor by the user (col. 4, lines 32-56 and col. 5, lines 16-22) by placing the containers for the first time on the tray (col. 4, lines 40-41) and scanning by scanner 13. Medication that is not already stored in the RAM and not recognized is manually input via a keyboard (col. 4, lines 43-48). However, whether the specifying information is stored in the RAM by the user scanning the containers or is programmed therein prior to use of the device would be a matter of obvious choice to the designer. Glynn apparently scans the containers

to determine which and how many medications are present in the tray. If sufficient memory space were available in the RAM, then one of ordinary skill in the art would recognize that all medication and dosage information could be stored therein prior to and without the need of the user inputting such data. Clearly, the size and cost considerations of the device of Glynn will dictate to one skilled in the art how much data may be stored in RAM 47.

7. Claim 108 is rejected under 35 U.S.C. 103(a) as being unpatentable over Glynn in view of Mucciacciaro. With respect to the separate sensing areas, Glynn suggests separate sensors positioned under each container (col. 6, line 46). Regarding separate visual indicators for the medication containers, It would be obvious for one of ordinary skill in the art having both references, at the time the invention was made, to provide a visual warning indicator in the Glynn system for identifying each container, as done in the Mucciacciaro device at 12, 24 as an obvious means for prompting the user to take the medication in the correct container.

***Claim Objections***

Claims 107-108 objected to because of the following informalities: claim 107 recites “sensing device” at line 13 lacking antecedent basis. Reference appears to be to “specifying device". Appropriate correction is required.

Claims 1, 7, 8, 15, 17, 23-27 and 36 are allowed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Vit W. Miska whose telephone number is 571-272-2108. The examiner can normally be reached on M-F 9-5:30.

The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Vit W. Miska/
Primary Examiner, Art Unit 2833